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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,308	01/19/2001	Takanori Terada	1046.1232/JDH	6758
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER MANTWANG, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2144	
			MAIL DATE	DELIVERY MODE
			07/14/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/764,308

**Applicant(s)**

TERADA, TAKANORI

**Examiner**

Joseph Maniwang

**Art Unit**

2144

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-6, 8-11, 13-15, 17-20, 22-24, 26 and 27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 2, 4-6, 8-11, 13-15, 17-20, 22-24, 26 and 27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notices of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

2. Claims 1, 2, 4-6, 8-11, 13-15, 17-20, 22-24, and 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Tafoya et al. (U.S. Pat. No. 6,952,805), hereinafter referred to as Tafoya.

3. Regarding claims 1, 10, and 19, Tafoya disclosed a method and system comprising detecting that a plurality of multicast target mail destination address exist in a history of mail delivery (see column 2, lines 25-28; column 6, lines 51-63; column 7, lines 23-64); setting an input count of the detected multicast target mail destination addresses in the history (see column 2, lines 25-28, 42-54; column 4, lines 57-67; column 6, line 65 through column 7, line 21; column 7, line 65 through column 8, line 18; column 13, lines 30-36); generating a group formed of the plurality of multicast target mail destination addresses detected in the history, said group capable of including destination address of various destination attributes, when the input count of the detected multicast target mail destination addresses reaches a predetermined number (see column 2, lines 25-41; column 6, line 65 through column 7, line 21; column 7, line 9-21; column 9, lines 27-39); and adding a group name of the generated group to group management information in said history of mail delivery (see column 4, lines 34-49).

4. Regarding claims 2, 11, and 20, Tafoya disclosed the method and system further comprising detecting that there does not exist a group corresponding to the plurality of multicast target mail destination addresses existing in the history (see column 7, lines 1-8); and if there does not exist a group corresponding to the plurality of multicast target mail destination addresses, generating the group (see column 4, lines 34-49).
5. Regarding claims 4, 13, and 22, Tafoya disclosed the method and system further comprising registering the added group name corresponding to the plurality of multicast target mail destination addresses (see column see column 7, lines 1-21).
6. Regarding claims 5, 14, and 23, Tafoya disclosed the method and system further comprising registering the added group name inputted by a user in the group management information in the registering the added group name (see column 3, line 61 through column 4, line 5).
7. Regarding claims 6, 15, and 24, Tafoya disclosed the method and system further comprising registering a piece of registration reject state information in the group management information when the user rejects the registration of the added group name in the registering the added group name (see column 11, lines 8-22).
8. Regarding claims 8, 17, and 26, Tafoya disclosed the method and system further comprising generating the group name by a predetermined algorithm and adding the generated group name to the group management information (see column 9, lines 50-65).

9. Regarding claims 9, 18, and 27, Tafoya disclosed the method and system further comprising enabling a user to select whether the generating the group is to be executed or not (see column 11, lines 42-50).

### ***Response to Arguments***

10. Applicant's arguments filed 04/02/08 have been fully considered but they are not persuasive.

11. Regarding independent claims 1, 10, and 19 rejected under 35 U.S.C. 102(b) as being anticipated by Tafoya, Applicant first asserts that the reference does not teach "generating a group formed of the plurality of multicast target mail destination addresses detected in said history of mail delivery, said group capable of including destination addresses of various destination attributes, when the input count of the detected multicast target mail destination addresses reaches a predetermined number" as claimed. Applicant's remarks selectively highlight and characterize the cited portions of Tafoya used in rejecting this limitation of the claims. However, Examiner does not find such characterizations particularly relevant to Applicant's assertion. Although Applicant generally asserts that "Tafoya fails to generate any groups including destination addresses of various destination attributes, when the input count of the detected multicast target mail destination addresses reaches a predetermined number", Examiner submits that Tafoya very clearly discloses in the cited portions that "The system and method automatically tracks and maintains entries, such as contacts or e-mail addresses and organizes and maintains the tracked entries in a dynamic resolution

list" (column 2, lines 25-41), "The PIM scans the data store from which it extracts email addresses and contact information that is weighted and used to initially populate a dynamic resolution list", "the invention preferably initially populates the resolution list with email and contact entries in the data store" (column 6, line 65 through column 7, line 21), and "repeated instances of email addresses or contact information within multiple items in the data store preferably serves to increase the weight of the associated entry in the resolution list" (column 9, lines 27-39). That is, in Tafoya, multiple instances of an e-mail address in a data store (i.e., "mail history") increase the weight (i.e., "predetermined number") used in populating a resolution list (i.e., "group"), which reads on the limitation argued. Additionally, although Applicant asserts that the reference does not teach "adding a group name" as claimed, Examiner submits that the mere creation of the "resolution list" in Tafoya inherently requires that such a data structure have a "group name" allowing it to be identifying/recognizable and accessible in within the system of Tafoya. Indeed, such referencing of the resolution list (presumably by "name") is evidenced in the disclosure, since "As a user begins to input an email address or contact, a system and method according to the present invention automatically suggests one or more entries, with the most likely entry preferably highlighted, by using the most probable results from the resolution list".

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on 8:00AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2151

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2151